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REMARKS

Applicant wishes to thank the Examiner for considering the present application. In the Office Action dated February 9, 2005, Claims 1-17 are pending in the application. Applicant hereby affirms the election of Claims 1-12 that are set forth in Group I by the Examiner.

Claims 1-7 and 9-12 stand rejected as being unpatentable over *Hendricks* (6,160,989) in view of *Beckmann* (6,675,388). Applicant respectfully traverses.

Claim 1 is directed to a system of broadcasting digital channels over an allocated frequency spectrum. Claim 1 recites a satellite, a network operations center uplinking electronic content to the satellite, and a terrestrial over-the-air digital broadcast center receiving the electronic content from the satellite and generating a digital channel signal over at least a portion of the allocated frequency spectrum. The terrestrial over-the-air digital broadcast center generates digital over-the-air electronic content over a second portion of the allocated frequency spectrum of an analog broadcast signal. Claim 1 was amended to clarify that the over-the-air digital broadcast center is a terrestrial system. Also, the vertical blanking interval set forth in the broadcast center clause has been removed for clarity.

The *Hendricks* reference is directed to network controller for cable television delivery systems. The *Hendricks* reference specifically mentions that the teachings may be applied to "home telephone lines, cellular networks, fiberoptics, Personal Communication Networks and similar technology for transmitting to the home" as set forth in Col. 7, lines 30-34. Applicant agrees that both a digital and analog tuner are illustrated as elements 3 and 5 of Fig. 2. Applicant agrees that an operations center satellite and a network controller are illustrated. However, as the Examiner sets forth, no second portion of the allocated frequency spectrum of an analog broadcast signal is taught in the *Hendricks* reference. The *Hendricks* reference also does not suggest a second portion of allocated frequency spectrum of an analog broadcast

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signal that is transmitted together with the digital channel over the first portion of the allocated frequency spectrum.

The *Beckmann* reference is set forth for a system that utilizes the vertical blanking interval of an analog broadcast system to deliver various data. Applicant agrees that the vertical blanking interval in *Beckmann* is used for various data. Also, as set forth in Col. 5, lines 29-30, the data may be streaming video or audio. The *Beckmann* reference has the signal delivered from an input cable 2 as illustrated in Fig. 2. Both a digital TV channel tuner 3 and an analog TV tuner 5 are illustrated in Fig. 2. The signals may also be delivered directly from the satellite to the set top box 16 which are then coupled to the tuner 18 and the tuner 19. No teaching is provided for a terrestrial-based over-the-air broadcast center.

The Examiner states, "it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable headend disclosed by Hendricks to be able to transmit some of the data or 'electronic content' within the VBI of an 'analog broadcast signal', as taught by Beckmann, in order to efficiently use the bandwidth available between the headend and user terminals thereby increasing the efficiency of the overall system." First, Applicant has amended the claims to remove the words "vertical blanking interval" with the second portion of allocated frequency spectrum. Applicant respectfully also submits that the Examiner is forming a hindsight reconstruction of the present invention using the teachings of the prior art.

It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to "[use] that which the inventor taught against the teacher." W. L. Gore v. Garlock Inc., 721 F. 2d 1540, 1553, 220 USPQ 301312-13 (Fed. Cir. 1983). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F. 3d

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at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. Clearly, no support, motivation or incentive is provided by the two cited references for such a combination. It is well-established that the prior art must make a suggestion of, or provide an incentive for a claimed combination of elements to establish a *prima facie* case of obviousness. See In re Oetiker, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pt. App. 1985). In this instance, however, no support, motivation or incentive is provided by the two cited references for the combination proposed by the Examiner. The *Hendricks* reference is clearly used as a generic communication system. Only conventional broadcasting without extra content is set forth.

Claim 9 is similar to Claim 1 in method form. Claim 9 recites the steps of uplinking a plurality of electronic content packages to a satellite, receiving the electronic content packages from the satellite, over-the-air broadcasting of the electronic content packages within excess bandwidth of a digital television broadcast signal from a terrestrial over-the-air broadcast center and receiving electronic content packages through a user appliance. Thus, Claim 9 is similar to Claim 1 in that electronic content packages are provided within the excess bandwidth of a digital television broadcast signal. The digital television broadcast signal is provided from a terrestrial over-the-air broadcast center.

Claims 2-7 and 10-12 are dependent upon independent claims 1 and 9. Applicant respectfully believes that these claims are also allowable for the same reasons set forth above.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hendricks* in view of *Beckmann* in further view of *Owa* (6,711,397). The *Owa* reference also does not teach or suggest the combination set forth by the Examiner. Applicant respectfully believes that these claims are also allowable for the same reasons set forth above.

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In light of the amendments and remarks above, Applicants submit that all rejections are now overcome. The application is now in condition for allowance and expeditious notice thereof is earnestly solicited. Should the Examiner have any questions or comments which would place the application in better condition for allowance, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,



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